

## **REMARKS**

### **I. PRELIMINARY REMARKS**

A minor amendment has been made to the specification in order to correct a typographical error. Claims 1, 49 and 51 have been amended. Claims 53-64 have been added. No claims have been canceled. Claims 1-26 and 43-64 remain in the application. Claims 3, 6-10, 12-16 have been withdrawn from consideration. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicant notes that the Examiner has indicated that claims 2, 18, 20-26, 43-46 and 52 have been allowed and that claim 51 would be allowable if rewritten in independent form. As claim 51 been rewritten in independent form, applicant respectfully submits that claim 51 is in condition for allowance.

### **II. PRIOR ART REJECTIONS**

#### **A. The Rejections**

Claims 1, 4, 5, 11, 17 and 19 have been rejected under 35 U.S.C. § 102 as being anticipated by the Stevens patent (U.S. Patent No. 5,419,340). Claims 47-50 have been rejected under 35 U.S.C. § 102 as being anticipated by the Ebling patent (U.S. Patent No. 4,934,340). The rejections under 35 U.S.C. § 102 are respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

#### **B. Discussion Concerning Claims 1, 4, 5, 11, 17 and 19**

Independent claim 1 calls for a combination of elements including "an elongate body," "a steering wire ... operably connected to the distal portion of the elongate body such that proximal movement of the steering wire will result in a pulling force being

applied to the distal portion of the elongate body,” “a stiffening member **secured to** the distal portion of the elongate body” and “a handle.” The Stevens patent fails to teach or suggest such a combination.

For example, the Stevens patent fails to teach or suggest the use of a stiffening member. The Stevens ball 76, which the Office Action appears to refer to as corresponding to the claimed “stiffening member,” merely promotes smooth movement of the control wire 20 and is not a “stiffening member.” The Stevens patent also fails to teach or suggest securing the ball 76 to the distal portion of the Stevens catheter 10. To the contrary, the ball 76 is free to move with the control wire 20.

As the Stevens patent fails to teach or suggest each and every element of the combination recited in independent claim 1, applicant respectfully submits that claims 1, 4, 5, 11, 17 and 19 are patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

### C. Discussion Concerning Claims 47, 48 and 50

The Ebling patent is directed to a bending assembly that may be used to steer a catheter through the body. As illustrated in Figures 7 and 8, the distal portion of a catheter 10b is provided with a contractile wire 20b and a fiber bundle 70, **both of which are secured** to a connecting member 24b. [Note column 6, lines 54-65.] The contractile wire 20b shrinks when current passes therethrough to deflect the catheter 10b.

Independent claim 47 calls for a combination of elements including “an elongate body,” “a stiffening member associated with the distal portion of the elongate body,” “an anti-tear device” and “a steering wire, which **is not connected** to the anti-tear device, having a distal portion operably connected to the distal portion of the elongate body.” The Ebling patent fails to teach or suggest such a combination. For example, even assuming for the sake of argument that, as asserted in the Office Action, the Ebling contractile wire 20b corresponds to the claimed “steering wire,” and that the Ebling connecting member 24b corresponds to the claimed “stiffening member,” and that the Ebling fiber bundle 70 corresponds to the claimed “anti-tear device,” the Ebling patent

clearly indicates that the contractile wire 20b **is connected** to the fiber bundle 70. More specifically, the Ebling patent indicates that “[t]he connecting member or wire loop 24b **serves to connect the contractile wire 20b to the fiber bundle 70.**” [Column 6, lines 63-65, emphasis added.]

As the Ebling patent fails to teach or suggest each and every element of the combination recited in independent claim 47, applicant respectfully submits that claims 47, 48 and 50 are patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

#### **D. Discussion Concerning Claim 49**

Independent claim 49 calls for a combination of elements comprising “an elongate body,” “a steering wire having a distal portion operably connected to the distal portion of the elongate body,” “a stiffening member associated with the distal portion of the elongate body and defining a proximal end” and “an anti-tear device, defining a proximal end and a distal end, secured to the proximal end of the stiffening member such that **the proximal end of the anti-tear device is located within the distal portion of the elongate body.**”

The Ebling patent fails to teach or suggest such a combination. For example, assuming for the sake of argument that the Ebling fiber bundle 70 corresponds to the claimed “anti-tear device” as asserted in the Office Action, the proximal end of the Ebling fiber bundle 70 is not located within the distal portion of the catheter 10b. To the contrary, one of skill in the art would understand that the fiber bundle 70 extends to the proximal portion of the catheter 10b so that the fibers can be connected to the associated equipment.

As the Ebling patent fails to teach or suggest each and every element of the combination recited in independent claim 49, applicant respectfully submits that claim 49 is patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

### III. NEWLY PRESENTED CLAIMS 53-64

Newly presented dependent claims 53 and 54 depend from independent claim 47 and are patentable for at least the same reasons as claim 47.

Newly presented independent claim 55 calls for a combination of elements comprising "an elongate body," "a steering wire having a proximal portion that extends to the proximal portion of the elongate body and a distal portion that is operably connected to the distal portion of the elongate body such that proximal movement of the steering wire will result in the steering wire pulling the distal portion of the elongate body," "a stiffening member associated with the distal portion of the elongate body" and "a handle." The respective combinations defined by claims 56-63 include, *inter alia*, the elements recited in claim 55. Applicant respectfully submits that the cited references fail to teach or suggest such combinations and that claims 55-63 are patentable thereover.

Newly presented independent claim 64 calls for a combination of elements comprising "an elongate body," "a stiffening member associated with the distal portion of the elongate body," "anti-tear means, associated with the stiffening member, for preventing the stiffening member from tearing through the elongate body" and "a steering wire, which is not connected to the anti-tear means, having a distal portion operably connected to the distal portion of the elongate body." Applicant respectfully submits that the cited references fail to teach or suggest such a combination and that claim 64 is patentable thereover.<sup>1</sup>

### IV. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the

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<sup>1</sup> "[T]he application of a prior art reference to a means or step plus function limitation requires that the prior art element perform the *identical function* specified in the claim." MPEP § 2182, emphasis added.

application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

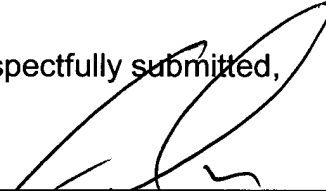
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

3/31/01  
Date

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Respectfully submitted,

  
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